Supreme Court, U.S.
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No. 00-470

In The

Supreme Court of the United States

LAS VEGAS SPORTS NEWS, LLC,
d/b/a LAS VEGAS SPORTING NEWS,

Petitioner,

v.

TIMES MIRROR MAGAZINES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Third Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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COUNTER-STATEMENT OF QUESTIONS PRESENTED

I. WHETHER THE COURT SHOULD EXERCISE ITS DISCRETION TO REVIEW THIS CASE WHEN THE RECORD IS INADEQUATE FOR REVIEW, REVIEW WOULD BE PREMATURE, AND THE PETITION SEEKS REVIEW OF ISSUES NOT DECIDED BY THE LOWER COURTS.

- (Negative answer sought by Respondent).

II. WHETHER THE COURT SHOULD EXERCISE ITS DISCRETION TO REVIEW THIS CASE TO DETERMINE WHETHER NICHE MARKET FAME SATISFIES THE FAME REQUIREMENT OF THE FEDERAL TRADEMARK DILUTION ACT ("FTDA") WHEN THE DECISIONS OF THE CIRCUITS CAN BE RECONCILED TO RESOLVE ANY PERCEIVED INCONSISTENCY.

- (Negative answer sought by Respondent).

III. WHETHER THE COURT SHOULD EXERCISE ITS DISCRETION TO REVIEW THIS CASE TO DETERMINE WHETHER THE FAMOUS AND DISTINCTIVE REQUIREMENTS OF THE FTDA ARE TWO SEPARATE REQUIREMENTS WHEN THE DISCUSSION OF THAT ISSUE BY THE COURT OF APPEALS WAS MERE DICTA, SINCE IT AFFIRMED SEPARATE FINDINGS OF FAME AND DISTINCTIVENESS.

- (Negative answer sought by Respondent).

IV. WHETHER THE COURT SHOULD EXERCISE ITS DISCRETION TO REVIEW THIS CASE TO DETERMINE WHETHER THE FTDA REQUIRES PROOF OF ACTUAL DILUTION WHEN THE ISSUE WAS NEVER ADDRESSED BY THE LOWER COURT.

- (Negative answer sought by Respondent).

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COUNTER-STATEMENT OF THE CASE

Factual Background

In 1886, "The Sporting News" was granted federal trademark registration as the banner headline for a weekly publication dedicated to in-depth analysis of sports. App. at 3a. Since 1886, the publication has been continuously published on a weekly basis throughout the United States and Canada. App. at 4a. It has become famous. "The Sporting News" has a current circulation of at least 540,000, and an even larger readership. App. at 4a. In the past five years, Times Mirror Magazines, Inc. ("Times Mirror") has spent millions of dollars in improving the magazine and its circulation, including increased publicity on television, radio and in direct mail solicitations and promotions. App. at 4a.

"Las Vegas Sports News" was a sports magazine with a focus on gambling. In 1997, the owner of Las Vegas Sports News changed the title of the magazine to "Las Vegas Sporting News." App. at 4a. This action was taken despite the fact the owner was aware of the existence of "The Sporting News." App. at 4a. Like "The Sporting News," "Las Vegas Sporting News" reports on football, basketball, baseball and hockey and is published, more or less, on a weekly basis. App. at 48a, 49a. Concurrent with the change of name, the color of words in that publication's title banner was changed. "Las Vegas" was printed in green and gold, leaving only the words "Sporting News" to appear in red typeface, the same color as the title of "The Sporting News." App. at 17a.

Times Mirror discovered Las Vegas Sporting News' unlawful use of its mark in August of 1997. App. at 5a.

Immediately thereafter, on September 24, 1997, Times Mirror sent to Las Vegas Sporting News a cease and desist letter. App. at 5a. The parties thereafter conducted settlement negotiations. App. at 5a. When no resolution could be reached, Times Mirror filed its complaint on October 30, 1998 in the Eastern District of Pennsylvania. App. at 52a.

Procedural Background

Times Mirror Magazines, Inc.'s complaint charged Las Vegas Sports News with infringing Times Mirror's registered trademark in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114(1) (1997); with false designation of original in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1998); with trademark dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) (1998); and with common law unfair competition and infringement. App. at 47a. A hearing was held on December 3, 1998 before District Judge Bruce Kauffman. Following the hearing, the District Court granted the request for a preliminary injunction, finding that Times Mirror was likely, pursuant to the Federal Trademark Dilution Act ("FTDA"), to prevail on its claim for trademark dilution by blurring. App. at 47a. The Court did not address Times Mirror's claim for dilution by tarnishment.

In finding that Times Mirror was likely to prevail on its claim of dilution under the FTDA, the District Court made numerous findings. Specifically, the Court found that The Sporting News is a famous mark in which Times Mirror has invested millions of dollars to protect and

increase its strength. App. at 55a. The District Court found that Las Vegas Sporting News was familiar with The Sporting News as of the date the Petitioner's publication changed its name. App. at 58a. The Court further found that due to the similarities of the two marks and the fact that the two publications compete in similar markets, Times Mirror is likely to prove that use of the mark Las Vegas Sporting News dilutes its mark, "The Sporting News." App. at 59a.

Petitioner appealed the decision of the District Court to the Third Circuit. During the pendency of the appeal, the parties agreed to stay Times Mirror's enforcement of the preliminary injunction. Following oral argument, a three-judge panel of the Third Circuit affirmed the decision of the District Court. By Stipulation, the stay of the preliminary injunction still remains in place.

The Third Circuit determined that the District Court did not commit reversible error in concluding that the federally registered trademark, The Sporting News, which has been continuously used throughout the United States and Canada since 1886, was a famous and distinctive mark entitled to protection under the FTDA. The District Court had applied the eight non-exclusive factors set forth in 15 U.S.C. § 1125(c)(1)(A)-(H), and determined that "The Sporting News" is a famous mark. App. at 13a-14a. The Third Circuit concluded that the District Court did not err in the application of these factors and in finding "The Sporting News" to be a famous mark. App. at 14a. The District Court had determined that "The Sporting News," although not a fanciful or arbitrary trademark, has acquired secondary meaning and thus distinctiveness. App. at 41a. This conclusion was based

on the District Court's findings that the mark has been used in commerce since 1886 and that Times Mirror has expended millions of dollars in advertising and promoting the mark in various media outlets. The Third Circuit agreed with the District Court's finding that "The Sporting News" has acquired secondary meaning and is thus distinctive. App. at 41a. Finally, in addressing the dilution argument, the Third Circuit found helpful the dilution analysis in *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999); it applied the *Nabisco* factors to the facts found by the District Court; and it found no error in the District Court's grant of the preliminary injunction. App. at 18a. Accordingly, the Third Circuit affirmed the decision of the District Court.

The decision of the Third Circuit was a two-to-one decision with a dissent authored by Judge Barry. Essentially, the dissent contended that Times Mirror presented insufficient evidence. App. at 21a. The only legal disagreement contained in the dissent was regarding the appropriateness of the niche market theory of fame. App. at 22a. However, the District Court never specifically addressed "niche market" in its opinion.

Petitioner thereafter filed a petition to the Third Circuit for rehearing en banc. The petition was denied with two judges dissenting.

REASONS FOR DENYING THE WRIT

The Petition for Writ of Certiorari filed by Las Vegas Sports News utterly fails to establish any compelling reason consistent with Supreme Court Rule 10 suggesting

that any aspect of the decision of the Third Circuit merits the attention of this Court. The opinion of the Third Circuit is thoroughly and soundly reasoned and is consistent, in all relevant aspects, with the decisions of other Courts of Appeal. Further, any possible inconsistencies are created due to the absence of a complete record. The only available record for review is that which was created during a preliminary injunction hearing, which fails to provide sufficient facts to permit a thorough analysis of the legal issues presented by Petitioner. There is no irreconcilable conflict among the circuits which affects this case. Further, the parties have agreed to stay the preliminary hearing until a decision can be reached following a full evidentiary trial.

I. This case does not present a clear, fully developed record sufficient to serve as a basis for deciding the complex and novel legal questions tendered by Petitioner. Further, adjudication of the issues would be premature, since trial in this matter may eliminate the alleged conflict between the holding of the Court of Appeals and decisions in other circuits. Finally, discretionary review should not be granted where the District Court has not yet even passed on the issues raised by the Petition.

A. The present record is insufficient to serve as the basis for review.

This case arises under the Federal Trademark Dilution Act of 1995 ("FTDA"), 15 U.S.C. § 1125(c). The FDTA created a new federal cause of action and a new federal remedy available to the owner of a "famous" mark, if the defendant's use of the plaintiff's mark, "causes dilution

of the distinctive quality of the mark." 15 U.S.C. § 1125(c)(1). Petitioner tenders for the Court's review three issues which it contends are novel under the FTDA: (A) whether the FTDA protects marks which are famous in a "niche market"; (B) whether the FTDA requires the senior mark to be both "famous" and "distinctive" (in the conjunctive), or whether under the Act "distinctiveness" is merely a synonym for "fame"; and (C) whether the FTDA requires proof of actual, consummated dilution, or just a likelihood of dilution. This case is not well suited to be the occasion for this Court's initial consideration of this important and complicated area of the law. Rather than deciding this matter now, the Court should deny this petition for writ of certiorari and permit the parties to develop a full record in District Court at trial on the permanent injunction.

The only evidentiary record in this case is a brief, comparatively thin hearing record before the District Court on Respondent's Petition for Preliminary Injunction. Petitioner presented no, or at best very modest, evidence on the issues it now argues (fame in a niche market versus fame to the public generally; "fame" and "distinctiveness" as supposedly separate elements; and actual, consummated, rather than merely threatened, dilution.) Further, as Petitioner concedes at page 6 of its Petition, the District Court made no specific finding as to the market in which Respondent's mark enjoys fame.

It is firmly established that, "review on writ of certiorari is not a matter of right, but of judicial discretion and will be granted only when there are special and important reasons therefor." U.S. Sp. Ct. Rule 10; Wright, Miller, Cooper & Cressman, *Federal Practice and Procedure*,

Ch.10, § 4004. Upon review, this Court requires that cases before it present legal and factual issues through a thorough, complete and accurate record. However, in the present case, the record is too, "skimpy in the sort of proved or admitted fact that would enable (this Court) to adjudicate," the issues presented. *Socialist Labor Party v. Gilligan*, 406 U.S. 583, 587 (1972). The record thus does not, "tender the underlying . . . issues in a clear-cut and concrete form." *Rescue Army v. Municipal Court*, 331 U.S. 549, 584 (1974).

It has long been this Court's, "considered practice not to decide abstract, hypothetical or contingent questions." *Alabama State Federation of Labor v. McAdory*, 325 U.S. 450, 461 (1945). This Court has often declined to decide even important issues in the absence of an adequate and full-bodied record. *Kleppe v. New Mexico*, 426 U.S. 529 (1976); *Philips v. Martin Marietta Corp.*, 400 U.S. 542, 540 (1970) ("The record before us is not adequate for resolution of these important issues."); and *Public Affairs Associates, Inc. v. Rickover*, 369 U.S. 111, 113 (1962) ("These are delicate problems; their solution is bound to have far-reaching import. Adjudication of such problems . . . should rest on an adequate and full-bodied record. The record before us is woefully lacking in these requirements").

The rather thin record made in the District Court (on a petition for preliminary injunction, rather than full trial on the merits) thus does not provide the kind of factual basis this Court ordinarily requires as a predicate for the adjudication of novel and serious issues. See, e.g., *Wainwright v. City of New Orleans*, 392 U.S. 598 (1967) (Harlan,

J., concurring); *Estelle v. Gamble*, 429 U.S. 97 (1976) (Stevens, J., dissenting).

In summary, this case lacks factual clarity and therefore presents difficult questions in a novel area of the law in a completely abstract fashion. Simply put, the record is, "too opaque to permit any satisfactory adjudication," of the issues Petitioner tenders. *Wainwright v. New Orleans, supra*. Given those circumstances, this case is one where the most appropriate disposition would be denial of the petition.

B. The Petition is premature. It raises legal issues and asserts conflicts that may not be presented when a factual record is developed in this case.

Petitioner contends that the decision of the Court of Appeals conflicts with decisions of other Circuits, as well as with the congressional intent underlying the FDTA. Petitioner's arguments are based on assumptions that when a full record is made at trial the District Court will conclude that Respondent's mark has niche market, but not general, "fame"; that Respondent's mark has "fame", but not "distinctiveness" (if those two terms are separate elements rather than synonyms); and that Respondent will be unable to prove actual, consummated (rather than merely threatened) dilution. To date, only the barest of records has been made on those issues, with the full record to be developed at the forthcoming trial on the permanent injunction. At trial, Petitioner's underlying assumptions may prove to be unfounded.

While the Court could conceivably use this case as the vehicle to decide the asserted conflict among the

Circuits, sound reasons counsel against doing so. If the Court were to address Petitioner's issues now, there is a substantial possibility that the Court's decision would be shown, on the basis of a more fully developed factual record, to have been unnecessary. Although the Court's decision would not be advisory in the Article III sense, the policies underlying the rule against advisory opinions – the need to limit the judicial function to deciding sharply defined issues reflecting real, concrete, fully litigated adversity between the parties – also counsel against deciding the questions Petitioner now raises. This Court should decline to review where, as here, the issues are presented in abstract, hypothetical form without the benefit of precision that would be afforded by a trial. *Rescue Army v. Municipal Court, supra.*

C. This Court should decline to review issues which were not passed upon by the District Court.

Examination of the District Court's Memorandum and Order shows that the District Court never passed upon the specific issues Petitioner tenders (niche market fame versus general fame; whether fame and distinctiveness are separate, conjunctive elements; and actual, consummated, versus threatened, dilution).

The Supreme Court ordinarily will not decide issues not litigated in the Trial Court. While the Court of Appeals did pass upon Petitioner's issues, the District Court did not specifically adjudicate them in its Memorandum and Order on the Preliminary Injunction (although the District Court surely will decide the issues

at the forthcoming trial on the merits). There is no doubt that this Court has jurisdiction to consider the issues, whether or not the Court of Appeals did so. *Springfield v. Kibbe*, 480 U.S. 257 (1987). It is respectfully suggested, however, that this case is not the occasion for the Supreme Court to decide the issues when the District Court failed to specifically address them. The sketchy, thin state of the record counsels against the Court exercising its discretion to review and adjudicate issues on which there has not yet been a Trial Court decision on a fully developed record.

II. This Court Should Not Exercise its Discretionary Review to Review Whether Niche Market Fame Satisfies the "Fame" Requirement of the Federal Trademark Dilution Act When the Decisions of the Circuit Courts can be Reconciled to Resolve any Perceived Inconsistency.

Petitioner argues that the decision of the Third Circuit concluding that, "a mark not famous to the general public is nevertheless entitled to protection from dilution where both the plaintiff and defendant are operating in the same or related markets, so long as the plaintiff's mark possesses a high degree of fame in its niche market," conflicts with the decisions of other Circuits. While Petitioner is correct that some Circuits have rejected the niche market theory, those decisions involved factual situations where the plaintiff and defendant were not operating in the same or similar market. On the other hand, no Circuit Court has rejected the niche market theory where the plaintiff and defendant competed in the same or similar market. Therefore, while there may at first

blush appear to be a conflict among the circuits, the perceived conflict evaporates upon closer review.

The most cogent, well-reasoned decision reconciling the apparent conflict among the circuits is the decision of the Seventh Circuit in *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633 (7th Cir. 1999). Specifically, the court found:

> At an initial glance, there appears to be a wide variation of authority on this issue. Some cases apparently hold that fame in a niche market is insufficient for a federal dilution claim, while some hold that such fame is sufficient. However, a closer look indicates that the different lines of authority are addressing two different contexts. Cases holding that niche market fame is insufficient generally address the context in which the plaintiff and defendant are using the mark in separate markets. On the other hand, cases stating that niche-market renown is a factor indicating fame address a context like the one here, in which the plaintiff and defendant are using the mark in the same or related marks. The validity of this distinction is supported by the Restatement . . .

Id. at 640. Further, the Restatement (Third) of Unfair Competition provides:

> A mark that is highly distinctive only to a select class of group of purchasers may be protected from diluting uses directed at that particular class or group. For example, a mark may be highly distinctive among purchasers of a specific type of product. In such circumstances, protection against a dilution of the mark's distinctiveness is ordinarily appropriate only

> against uses specifically directed at that particular class of purchasers . . .

Restatement (Third) of Unfair Competition § 25 cmt. e. (1995 Main Vol.).

In support of its claim that some courts have rejected the niche-market theory, Petitioner cites to *I.P. Lund Trading ApS v. Kohler*, 163 F.3d 27 (1st Cir. 1998) and *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868 (9th Cir. 1999). As recognized by the reasoning in *Syndicate Sales*, those two decisions can be reconciled with, and do not conflict with, the decision of the Third Circuit in the present case.

In *I.P. Lund*, the First Circuit reversed the decision of the District Court granting a preliminary injunction enjoining Kohler Company from selling a faucet resembling Plaintiff's faucet. In reversing the District Court, the First Circuit determined the District Court erred in finding that Plaintiff's trade dress was "famous." A careful review of the Court's decision reveals that the First Circuit *never* rejected the niche-market theory. Rather, the First Circuit concluded, "[t]he record here reflects that there was not sufficient attention paid to the heightened fame standard the FTDA establishes." *Id.* The First Circuit found that Kohler had never used Plaintiff's product by name. *Id.* The First Circuit concluded, "[t]here is little to suggest that this product design, itself unregistered and not inherently distinctive, is so strong a mark and so well publicized and known that it has achieved the level of fame Congress intended under the Act." *Id.* Therefore, the First Circuit found that Lund's trade dress failed to meet a threshold standard of "fame" in the first instance (because it was merely an unregistered, not inherently

distinctive, product design). The court never specifically addressed niche market fame vs. general fame, because it found an absence of fame (at all) in the first instance.

Similarly, the decision in *Avery Dennison* does not create a split of authority among the Circuits. *Avery Dennison* was a claim by an office products manufacturer against a seller of vanity e-mail addresses. Avery Dennison claimed that Sumpton's use of the internet domain names <avery.net> and <Dennison.net> diluted the distinctive quality of Plaintiff's "Avery" and "Dennison" marks used on office products. The District Court granted Avery Dennison summary judgment on its FTDA claim. In reviewing the District Court's finding of fame, the Ninth Circuit applied the eight non-exclusive considerations for the famousness inquiry as set forth in Section 1125(c)(1) of the Act. Ultimately the Ninth Circuit found:

> The drafters of the Federal Trademark Dilution Act broke from the Trademark Review Commission's recommendation that only marks 'which have become famous throughout a substantial part of the United States' could qualify for protection. [citation omitted] Instead fame in a localized trading area may meet the threshold element under the Act if plaintiff's trading area includes the trading area of the defendant. [citations omitted] The rule is likewise for specialized market segments: specialized fame can be adequate only if the diluting uses are directed narrowly at the same market segment. [citation omitted]. No evidence on the record supports Avery Dennison's position on these two prongs of the famousness inquiry.

Id. Accordingly, the Ninth Circuit's decision in Avery Dennison turns on the sufficiency of the evidence. Like the decision in *I.P. Lund*, the Ninth Circuit found insufficient evidence of "fame," regardless of whether fame was analyzed on a niche market, or "general" fame, basis. Thus, despite Petitioner's argument, there is no conflict among the circuits. While other circuits have discussed the niche market theory, no other decision has rested upon a pure finding of niche market fame. Instead, both of the perceived conflicts Petitioner argues were decided on the basis of insufficient evidence of "fame", even in a niche market. The different results of the Court of Appeals' decisions do not suggest a conflict of interpretation of the law; they instead reinforce the view that the outcomes of FTDA cases are fact-sensitive and depend upon a careful assessment of the factual record.

The FTDA creates a federal cause of action protecting strong, well-recognized marks, even in the absence of a likelihood of confusion. As stated by the Third Circuit, "[t]he dilution doctrine is founded upon the premise that a gradual attenuation of the value of a famous trademark, resulting from another's unauthorized use, constitutes an invasion of the senior user's property rights in its mark and gives rise to an independent commercial tort for trademark dilution." One element of trademark dilution is the requirement that a mark be famous. The Act is clear that to meet the famousness requirement, the senior mark must be truly prominent and renowned. *Avery Dennison, supra.* However, nothing contained in the Act itself or the legislative history states that fame in a niche market is insufficient when the plaintiff and defendant operate in the same, or a closely related market. Accordingly, since

there is not a conflict among the Circuits, this question is not appropriate for review by the Supreme Court on that basis.

III. The Supreme Court Should Not Exercise its Discretion to Review this Case to Determine Whether the "Famous" and "Distinctive" Requirements of the FTDA are Separate Requirements, When the Discussion of that Issue by the Court of Appeals was Mere Dicta, Since it Affirmed Separate Findings of Fame and Distinctiveness.

Petitioner argues that this Court should grant certiorari to determine whether the "famous" and "distinctive" requirement of the FTDA are two separate requirements. While that is a novel, interesting issue, it played no role in the ultimate outcome of the Court of Appeals' decision. The Third Circuit's discussion was instead dicta, and this court should not exercise its discretion to review the merits of dicta.

The District Court addressed the "distinctive" requirement during its analysis of "fame." Specifically, the District Court found that Respondent was likely to prove that the mark, THE SPORTING NEWS, had acquired distinctiveness due to secondary meaning. The Third Circuit also specifically found that The Sporting News mark has acquired secondary meaning and thus is distinctive. Petitioner relies on the Third Circuit's statement that "we are not persuaded that a mark be subject to separate tests for fame and distinctiveness," to argue that the Third Circuit has found that the famous and distinctive requirements of the FTDA are synonymous. However, the above referenced statement of the Third Circuit

is merely dicta because the Court ultimately concludes the mark is distinctive. The Third Circuit specifically states,

> [i]n any event, we have already addressed in separate contexts the famousness and distinctiveness of "The Sporting News." *See supra* Part III.A. (fame in a niche market); *supra* Part III.B.I. (Distinctiveness acquired from secondary meaning). App. at 43a.

Id. Accordingly, while the Third Circuit engaged in a discussion of the competing views as to whether the FTDA requires separate tests for fame and distinctiveness, its discussion was ultimately and fundamentally dicta, since it found that Respondent satisfied both branches (if separate) in any event. Since the issue Petitioner seizes upon at this point of its argument played no role in the Third Circuit's ultimate outcome, certiorari should not be granted to review an issue which was dicta.

IV. The Supreme Court Should Not Exercise its Discretion to Review the Issue Whether the FTDA Requires Proof of Actual Dilution When this Issue Was Never Addressed by the Lower Court.

Petitioner finally argues the Court should grant certiorari to provide guidance to the Circuits as to whether the FTDA requires proof of actual, consummated harm (as compared to threatened dilution). This is an issue where there is an apparent conflict among the Circuits. The Fourth Circuit, *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Division of Travel Development*, 170 F.3d 449 (4th Cir. 1999), *cert. denied*, 120 S.Ct. 286 (1999),

and the Fifth Circuit, *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000), both hold that the FTDA requires actual dilution (in the sense of economic harm to the famous mark's selling power). The Second Circuit, *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999) expressly disagrees with the Fourth Circuit's *Ringling Bros.* interpretation of the FTDA, characterizing it as, "excessive literalism to defeat the intent of the statute." While there in fact may be a genuine conflict among the circuits, the present case is not the vehicle which the Court should choose to resolve the conflict.

As noted above, the only proceeding in District Court has been a hearing on a Petition for Preliminary Injunction. At the preliminary injunction stage, the moving party need only provide a likelihood of success on the merits. *Pappan Enterprises, Inc. v. Hardees Food Systems, Inc.*, 143 F.3d 800 (3d Cir. 1998). The District Court found that Respondent was likely to succeed on the merits of its dilution claim, and the Third Circuit found no "obvious error". However, neither the District Court nor the Court of Appeals specifically addressed the "actual dilution" vs. "threatened dilution" issue. The District Court may have decided, and the Third Circuit may have affirmed, that actual dilution is required, and then determined that the Respondent is likely to prevail on that issue. On the other hand, the District Court may have (without discussion) adopted the threatened dilution standard, and found that the Respondent was likely to prevail on that basis. Petitioner reads more into the Third Circuit's decision than is merited; the Court of Appeals likewise never discussed the actual dilution vs. threatened dilution

debate.[1] Therefore, it is at best speculation to assume that the Third Circuit has come down on one side of the issue or the other, and that this case is therefore the appropriate vehicle for the Supreme Court to resolve the conflict of law. Further, a full fact record is yet to be made, and at trial Respondent may well satisfy the actual dilution standard which Petitioner urges the Court to adopt. As discussed more fully above, this Court generally does not, and should not, exercise its discretion to review cases where the record is too thin, the issues raised by the petition are abstract or hypothetical, and where the question framed on the Petition for Certiorari, is in fact not fully presented by the record. Petitioner's final issue (actual vs. threatened dilution) falls into those categories of questions not ordinarily reviewed by the Supreme Court, and the petition should therefore be denied.

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[1] The majority opinion of the Third Circuit found that the District Court did not err by determining that Petitioner would be irreparably harmed if the preliminary injunction did not issue. The majority did not expressly discuss whether the harm it was referring to was threatened dilution or actual, consummated dilution. Judge Barry, writing in dissent, concluded that the majority, by finding lack of error even in the absence of actual economic harm, impliedly sided with *Nabisco* on this topic and rejected the Fourth Circuit's position in *Ringling Bros.* Judge Barry agreed with the *Nabisco* reasoning and with what she characterized as the majority's apparent rejection of *Ringling Bros.* However, the majority never did expressly discuss the threatened vs. actual dilution debate and the majority's position can be discerned, if at all, only by implication, not by reasoned discussion of the *Nabisco/Ringling Bros.* split of authority.

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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